

**REMARKS**

Reconsideration of this application, in view of the foregoing amendment and the following remarks, is respectfully requested.

Claims 1-5 were originally presented for consideration in this application. Claims 6-14 were added by previous amendments. Claims 5 and 9 have previously been canceled without prejudice or disclaimer. Accordingly, claims 1-4, 6-8 and 10-14 are currently pending in this application.

The following rejections were set forth in the Office Action:

1. Claims 6-8 stand rejected under 35 USC §102(b) as being unpatentable over U.S. Patent No. 6,173,788 (Lembcke).
2. Claims 1-4, 10-12 and 14 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,173,788 (Lembcke) in view of U.S. Patent No. 4,137,970 (Laflin).

Regarding the anticipation rejection of independent claim 6 based on the Lembcke reference, please note that this claim has been amended above. Claim 6 now requires that the inner surface of the packer is circumferentially continuous prior to actuation of the packer, in combination with the other elements recited in the claim.

Lembcke does not describe such a packer. Instead, Lembcke describes (see FIGS. 1a & 2a) multiple sealing elements 12 which are not circumferentially continuous. Therefore, Lembcke does not anticipate claim 6, and withdrawal of the rejections of this claim and its dependents is respectfully requested.

Regarding the obviousness rejections based on the Lembcke and Laflin references, please note that independent claims 1 and 11 have been amended above to require that the slit extends between the through-going opening and only one of the inner and outer surfaces of the packer prior to actuation of the packer. In contrast, Lembcke describes (see FIGS. 1a & 2a) that a slit extends between the groove 14 and both of the inner and outer surfaces of the packer.

Since neither of the Lembcke and Laflin references teaches or suggests the features of the invention as now recited in claims 1 and 11, a *prima facie* case of obviousness does not exist for these claims. Accordingly, withdrawal of the rejections of these claims and their dependents is respectfully requested.

In view of the foregoing amendment and remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 1-4, 6-8 and 10-14 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

SMITH IP SERVICES, P.C.

/Marlin R. Smith/

Marlin R. Smith  
Attorney for Applicant  
Registration No. 38,310

Dated: October 9, 2009

P.O. Box 997  
Rockwall, Texas 75087  
(972) 516-0030 (phone)  
(972) 516-0608 (fax)

I hereby certify that this correspondence is being  
filed in the U.S. Patent and Trademark Office  
electronically via EFS-Web, on October 9, 2009.

/Sally Ann Smith/

---

Sally Ann Smith